

REMARKS

Applicant submits this Reply to the Office Action mailed April 9, 2008. By this Reply, Applicant requests reconsideration of the outstanding claim rejections. Accordingly claims 1-32, 35, and 37-42 remain pending.

In the Office Action, claims 1-6, 8, 10-16, 18, 20-27, 29, 31, 32, 35, 37, 39, 41, and 42 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,208,979 to Sinclair (“Sinclair”); claims 9, 19, 30, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sinclair; and claims 7, 17, 28, and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sinclair in view of U.S. Patent No. 6,112,190 to Fletcher et al. (“Fletcher”). Applicant respectfully traverses the rejections for the reasons provided below.

Applicant thanks the Examiner for withdrawing the finality of the Office Action mailed on August 24, 2007.

The Office Action states that it is “[r]esponsive to communication(s) filed on 07 February 2008.” Office Action Summary page. However, it seems the Office Action has not considered the “Amendments to the Claims” and “Remarks” filed on February 9, 2008. For example, in applying Sinclair and Fletcher, the Office Action disregards the features added via amendment on February 9, 2008. In addition, although Applicant canceled claims 33, 34, and 36 in the Reply filed on February 9, 2008, the Office Action indicates that claims 1-42 are pending (Office Action Summary page), and the discussion of the claim rejections continues to include canceled claims 33, 34, and 36. Finally, the Office Action does not comment on Applicant’s remarks also filed on

February 9, 2008. Accordingly, Applicant respectfully requests reconsideration of the outstanding claim rejections and the timely allowance of all pending claims.

As presented in remarks filed on February 9, 2008, Sinclair does not disclose each and every element of the claimed features. For example, claim 1 recites “[a] computer based method for automatically creating a list of financing documents for a transaction,” including *inter alia* “preparing the decision criteria document, the decision criteria document having a plurality of data fields to be completed; receiving completed data fields; developing a set of selection criteria; and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing documents.”

Sinclair discloses “[a] computer-driven information management system [that] selectively matches credit applicants with money lenders through a global communications network.” Sinclair, Abstract. Sinclair further discloses that “finance institutions create customized electronic model profiles by entering into the System characteristics they judge to be indicative of a ‘desirable’ credit applicant.” See Sinclair, col. 7, ll. 31-33. For example, in Sinclair, qualifiers included in the creation of the electronic model profile might be “the applicant’s gross monthly income, state where dealer is located, number of months the applicant has been employed at present job, number of years the applicant has been residing at present address, and the like.” Sinclair, col. 7, ll. 39-43 In other words, the “customized electronic model profile” in Sinclair refers to creating profiles, according to characteristics deemed by the “finance institutions” to be indicative of a “desirable” credit applicant. Sinclair, col. 7, ll. 31-43.

Sinclair fails to disclose or even suggest “preparing the decision criteria document, the decision criteria document having a plurality of data fields to be completed; receiving completed data fields; developing a set of selection criteria; and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing documents,” as recited in claim 1. Although Sinclair discloses “generat[ing] and forward[ing] necessary documents to the finance institution to finalize the loan transaction,” (Sinclair, col. 9, ll. 6-7), Sinclair fails to specifically disclose “developing a set of selection criteria; and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing documents,” as recited in claim 1. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(e) of claim 1 and its dependent claims 2-6, 8, and 10-11.

Independent claims 12, 22, 32, and 42, although of different scope, recite features similar to those of claim 1. For example, claim 12 recites, among other things, “preparing the decision criteria document, the decision criteria document having a plurality of data fields as a function of the initial information; receiving completed data fields; generating rules for choosing a required set of documents; and automatically selecting the required set of documents based on the rules and preparing the list of financing documents.” Claim 22 recites, among other elements, a “computer application being adapted to receive a request for a decision criteria document from the finance computer application and prepare the decision criteria document, the decision criteria document having a plurality of data fields to be completed, to receive completed data fields from the finance computer application, to develop a set of selection criteria, and to

automatically select a required set of documents based on the set of selection criteria, and prepare the list of financing documents.” Claim 32 recites, among other features, “computer application being adapted to receive a request for a decision criteria document from the finance computer application and prepare the decision criteria document, the decision criteria document having a plurality of data fields to be completed, to receive completed data fields from the finance computer application, to generate a criteria for selecting a required set of documents based on the completed data fields, and to automatically choose the required set of documents based on the generated criteria and prepare the list of financing documents.” Claim 42 recites, among other things, “computer readable program means for receiving the decision criteria document and completing the data fields; automatically generating a criterion for selecting a required set of documents based on the completed data fields; and computer readable program means for receiving the generated criterion and automatically choosing a required set of documents based on the completed data fields and preparing the list of financing documents.” As noted above in connection with claim 1, Sinclair fails to disclose or suggest at least the above recitations. Accordingly, the rejection of claims 12, 22, and 32 under 35 U.S.C. § 102(e) should be withdrawn. Dependent claims 13-16, 18, 20-21, 23-27, 29, 31, 35, 37, 39, and 41 which depend from one of independent claims 12, 22, and 32, are allowable for at least the same reasons claims 12, 22, and 32 are allowable.

Claim 9 depends from 1, claim 19 depends from claim 12, claim 30 depends from claim 22, and claim 40 depends from claim 32. With respect to the 35 U.S.C. § 103(a) rejection of claims 9, 19, 30, and 40 as being unpatentable over Sinclair, Applicant

respectfully requests that the Examiner reconsider and withdraw the rejection because a *prima facie* case of obviousness has not been established. A *prima facie* case of obviousness has not been established because, among other things, Sinclair fails to disclose or suggest the features recited in independent claims 1, 12, 22, and 32.

Accordingly claims 9, 19, 30, and 40 are allowable for at least the same reasons that claims 1, 12, 22, and 32 are allowable.

Claim 7 depends from 1, claim 17 depends from claim 12, claim 28 depends from claim 22, and claim 38 depends from claim 32. Regarding the 35 U.S.C. § 103(a) rejection of claims 7, 17, 28, and 38 as being unpatentable over Sinclair in view of Fletcher, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection because a *prima facie* case of obviousness has not been established.

For example, as discussed above in connection with claim 1, Sinclair does not disclose “[a] computer based method for automatically creating a list of financing documents for a transaction,” including *inter alia* “preparing the decision criteria document, the decision criteria document having a plurality of data fields to be completed; receiving completed data fields; developing a set of selection criteria; and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing documents.” Fletcher does not cure the deficiencies of Sinclair. Indeed, the Office Action does not rely on Fletcher for disclosing the above recitation. Instead, the Office Action alleges that Fletcher “teaches the step of allowing a user to override the required set of documents.” Office Action at 4. Even assuming this allegation is correct, which Applicant does not concede, it does not constitute a teaching of the above recitation of claim 1. Moreover, the Office Action does not

indicate why the differences between Sinclair and Fletcher and claim 1 would have been obvious to an ordinarily skilled artisan. See MPEP § 2141(III). Accordingly Applicant respectfully requests withdrawal of the Section 103(a) rejection of dependent claim 7.

Similarly, as discussed above in connection with independent claims 12, 22, and 32, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of dependent claims 17, 28, and 38.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and drawings in this Reply, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly to the maximum extent permitted by statute, regulation, and applicable case law.

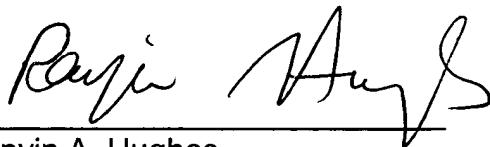
In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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